

REMARKS

I. STATUS OF CLAIMS

Claims 1-69 are pending. Claims 58-65 and 67 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142(b), as being drawn to a non-elected invention. Claims 3-11 have been amended to correct a typographical error in the recitation [HCO₃]. Specifically Applicants have amended the recitation [HCO₃] in claims 3-11 to include a negative charge. As the Examiner points out on page 7 of the Office Action, bicarbonate is an anion, and it has a negative charge. Thus, Applicants submit that one of ordinary skill in the art would have readily recognized the typographical error in claims 3-11 and the appropriate correction. In addition, the present amendments delete the phrase “derivatives thereof” from claim 19, without prejudice or disclaimer. No new matter has been added by these amendments.

II. PRIORITY

The Examiner notes that neither the first page of the certified English-language translation of the provisional application nor the first page of the certified English-language translation of the foreign priority document identifies the provisional or foreign priority document by its application number. Office Action at page 2. The first page of each of these certified translations indicates that the document “is a true and correct translation of the accompanying document in the French language.” However, Applicants inadvertently failed to attach the accompanying French language document when submitting the certified translations to the Office in U.S. Provisional Application No. 60/507,119 and the present application. To clarify the record, Applicants submit herewith as Exhibit 2, a certified English-language translation of foreign priority

document, FR 02 15051, which includes the accompanying French language document, FR 02 15051 referenced in the certification. Applicants also re-submitted a copy of the certified English-language translation of the provisional application, which includes the accompanying French language document referenced in the certification, in U.S. Provisional Application No. 60/507,119. A copy of the electronic filing receipt confirming the filing of the certified English-language translation in U.S. Provisional Application No. 60/507,119 is submitted herewith as Exhibit 1.

III. INFORMATION DISCLOSURE STATEMENT

Applicants respectfully request that the Examiner initial and return the IDS Form PTO/SB/08 filed March 11, 2008, indicating that she has considered the documents listed therein.

IV. REJECTIONS UNDER 35 U.S.C. § 112

A. Rejection under 35 U.S.C. § 112, first paragraph

The Examiner maintains the rejection of claims 1-57, 66 and 68-69 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Office Action at page 2. The Examiner asserts that “[o]ne of skill in the art would not recognize from the disclosure that the applicant was in possession of the genus drawn to ‘all derivatives recited in claim 19 for the dye precursors.’” *Id.* at page 3.

While Applicants do not agree with the merits of the Examiner’s assertions for the reasons already of record, solely in an effort to advance prosecution and without disclaiming any subject matter, Applicants have deleted all recitations of the phrase

“derivatives thereof” from claim 19. In view of the foregoing, the rejection is now moot, and Applicants respectfully request that the Examiner withdraw the rejection.

B. Rejection under 35 U.S.C. § 112, second paragraph

The Examiner maintains the rejection of claims 3-11, and 19 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Office Action at page 6.

The Examiner asserts that there is no charge for [HCO₃] recited in claims 3-11. See *id.* While Applicants do not agree with the merits of the Examiner’s assertions, solely in an effort to advance prosecution and without disclaiming any subject matter, Applicants have changed each occurrence of [HCO₃] in the claims to [HCO₃₋].

In addition, the Examiner further asserts that the expression “derivatives thereof” in claim 19 is without metes and bounds. Office Action at page 7. While Applicants do not agree with the merits of the Examiner’s assertions for the reasons already of record, solely in an effort to advance prosecution and without disclaiming any subject matter, Applicants have deleted all recitations of the phrase “derivatives thereof” from claim 19.

In view of the amendments, Applicants submit that the rejection is rendered moot and respectfully request that the Examiner withdraw the § 112, second paragraph rejection.

V. REJECTIONS UNDER 35 U.S.C. § 103

The Examiner maintains the rejection of claims 1-41, 50-53, 66 and 68-69 under 35 U.S.C. § 103(a) as allegedly being obvious over the combination of WO 02/30375 to Pruche (“Pruche”) and U.S. Patent No. 6,736,861 to Patel et al. (“Patel”), for the reasons of record. Office Action at page 9. The Examiner asserts that the difference between Pruche and the claimed invention is that Pruche fails to teach a composition also having an acidic composition or a basic composition. See *id.* at page 10. The Examiner turns to Patel to supplement the deficiencies of Pruche. See *id.* The Examiner asserts that Patel teaches coloring hair using an acidic and basic composition. See *id.* The Examiner asserts that it would be obvious to one of ordinary skill in the art at the time the invention was made to add the acidic and basic compositions of Patel to the hair coloring compositions disclosed in Pruche because “it is *prima facie* obvious to combine two compositions which have been used individually for the same purpose since the idea of combining the ingredients flows logically from the art.” *Id.* Applicants respectfully disagree and traverse the rejection for the reasons of record and the additional reasons discussed below. As in the previous response, all citations to Pruche refer to U.S. Patent No. 6,953,486.

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;

(3) Resolve the level of ordinary skill in the pertinent art; and

(4) Evaluate evidence of secondary considerations.

383 U.S. at 17, 148 U.S.P.Q. at 467. The obviousness or nonobviousness of the claimed invention is evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; see also *KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385, 1391 (2007).

As discussed above, the Examiner asserts that it would be obvious to add the hair care composition of Patel comprising a mixture of an acidic composition and a basic composition to the hair coloring compositions disclosed in Pruche to arrive at Applicants' claimed invention. See Office Action, at page 10. However, Applicants maintain that Pruche actually teaches away from such a combination. As the Examiner points out at page 11 of the Office Action, "a prior art reference that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness . . ." Applicants wholeheartedly agree. At col. 8, lines 19-20, Pruche teaches that its' compositions have the advantage of not requiring the use of hydrogen peroxide. Patel, on the other hand, discloses a daily hair care composition comprising a mixture of two compositions, part A and part B. See col. 3, lines 10-11. According to Patel, Part A is dye intermediates in a conditioner or shampoo base at alkaline pH, and Part B is hydrogen peroxide in a conditioner or shampoo base at acidic pH. See col. 3, lines 12-15 (emphasis added). Based on the teaching of Pruche, one of ordinary skill would have been unlikely to include the composition disclosed in Patel, wherein one component contains hydrogen peroxide, in the coloring compositions taught therein. At

least because Pruche teaches away from the Examiner's proposed combination, the Examiner has failed to set forth a *prima facie* case of obviousness.

In the present Office Action, the Examiner relies on *In re Gurley*, 27 F.3d 551, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994), as further support for maintaining the § 103 rejection. Office Action at page 11. Applicants submit that the facts in *Gurley* are different from the facts in the present case and, therefore, the holding is inapplicable. Unlike the reference in *Gurley*, the teaching away in Pruche is sufficient to establish patentability of the claimed invention. Specifically, in *Gurley*, the claims were directed to an epoxy based printed circuit material. See 27 F.3d at 552, 31 USPQ2d at 1131. The primary reference relied upon in the § 103 rejection, Yamaguchi, disclosed a polyester-imide resin based printed circuit board, and taught that although epoxy based materials have acceptable stability and some degree of flexibility, they are inferior to polyester-imide resin based materials. See 27 F.3d at 552-553, 31 USPQ2d at 1131-1132. While the court recognized Yamaguchi's teaching of the deficiencies of epoxy-impregnated resins, the court ultimately held that the claims would have been obvious over the prior art because the reference taught that epoxy resin based material was useful for applicant's claimed purpose, applicant did not distinguish the claimed epoxy from the prior art epoxy, and applicant asserted no discovery beyond what was known in the art. See 27 F.3d at 553, 31 USPQ2d at 1132.

Unlike the primary reference relied upon in *Gurley*, Pruche does not merely teach that a composition comprising hydrogen peroxide is inferior. Rather, Pruche teaches the advantage of their compositions is not requiring hydrogen peroxide as an additive. In addition, unlike the applicant's in *Gurley*, in the previous response Applicants pointed

out that paragraphs [013]-[014] of Applicants' specification discusses the coloring agent of Pruche ((WO 02/30375) and how the claimed invention has improved upon the coloring agent described therein. Prior art must be considered in its entirety, i.e., as a whole, including disclosures that lead away from the claimed invention. See M.P.E.P. § 2141.02(VI). Indeed, the Federal Circuit has recognized that proceeding contrary to the accepted wisdom in the art represents "strong evidence of unobviousness." *In re Hedges*, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986). Here, adding hydrogen peroxide to Pruche's compositions would be proceeding contrary to the teachings of the reference. Accordingly, Applicants submit that the claimed composition would not have been obvious over the combination of Pruche and Patel. As such, the Examiner has failed to establish a *prima facie* case of obviousness, and Applicants respectfully request that the Examiner withdraw the rejection.

VI. DOUBLE PATENTING REJECTION

The Examiner maintains the rejection of claims 1-41, 50-53, 66 and 68-69 for obviousness-type double patenting over claims 1-32 of U.S. Patent No. 6,953,486 to Pruche ("Pruche") in view of U.S. Patent No. 6,736,861 to Patel et al. ("Patel") for the reasons of record. Office Action at page 12. The Examiner asserts that claims 1-41, 50-53, 66 and 68-69 are not patentably distinct from claims 1-32 of Pruche in view of Patel for the reasons set forth regarding the § 103 rejection over the combination of these references discussed in Section V.A. above.

As discussed in Section V above, Pruche teaches away from including a hydrogen peroxide component, as disclosed in Patel, in a coloring composition. Accordingly, for at least the reasons discussed in Section V above, the claimed

invention would not have been *prima facie* obvious over the combination of Pruche and Patel.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the obviousness-type double patenting rejection.

VII. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 5, 2008

By: Jennifer Leach
Jennifer R. Leach
Reg. No. 54,257

Attachments:

Exhibit 1: Electronic filing receipt dated September 5, 2008, confirming filing of the certified English-language translation in U.S. Provisional Application No. 60/507,119, which includes the accompanying French language document referenced in the certification.

Exhibit 2: Certified English-language translation of foreign priority document, FR 02 15051, which includes the accompanying French language document, FR 02 15051, referenced in the certification.